

Remarks

Claims 1-12 and 54-64 were cancelled in a previous response. Claims 13-20, 25-35, 40-53 and 65-114 have been withdrawn from consideration. Therefore, claims 21-24, 36-37, and 38-39 (in part) are presently pending in the instant application.

RESTRICTION/ELECTION

Applicant had elected group VII which consists of claims 21-24, 36-37 and 38-39 (in part). The other claims have been either canceled or withdrawn from consideration.

DEFINITENESS

Claims 21-24 and 37-39 stand rejected under 35 U.S.C. § 112, second paragraph. The Office alleged that the term “metal ion chelating agents” in the claims could be interpreted as constituting chelating agents that are metal-containing or chelating agents that are non-metal-containing. The Office also alleged that the term “agent” is unclear.

Applicant respectfully traverses the rejection. The agent refers to a structure that does not contain a metal. The choice of substituents on the structure recited in the claims does not include a metal. Accordingly, the agent clearly does not refer to a chelating agent that contains a metal. Nevertheless, to clarify the claims, Applicant has amended the claim to recite the specific compound and its function. That is, the compound does not contain a metal, as clearly depicted in the chemical structure and described in the choice of substituents. Further, because the compound can chelate or bind a metal, it cannot be assumed to contain a metal.

NOVELTY

Claims 21, 24, 36 and 39 stand rejected under 35 U.S.C. § 102 for allegedly being anticipated by U.S. patent no. 3,474,168 (Schayer et al.). The Office contended that Schayer

taught picolinic acid derivatives in a composition for topical administration, including an ophthalmic preparation. The Office referred to Example 6 of Schayer.

Applicant respectfully submits that Schayer does not anticipate the claims. To anticipate, Schayer must teach each and every element of the claims. Schayer does not teach the picolinic acid of the claims. Column 2 of Schayer describes alpha-picolinic acid di-loweralkyl-amides. The present invention does not encompass an amide of picolinic acid. Moreover, the picolinic acid derivative in Schayer is used to alleviate the side effects of corticosteroids. The picolinic acid derivatives do not treat inflammation; it alleviates the side effects of corticosteroids. The patent describes the side effect as a dangerous closure of microvascular sphincters. In addition, Example 6 describes an ophthalmic preparation that does not contain picolinic acid or its derivative.

The Office further alleged that claim 36's recitation of "for the control of angiogenesis" was not sufficient to distinguish the invention from the prior art and that the claim should recite a structural difference.

By prior art, Applicant assumes that the Office is referring to Schayer et al. As discussed above, Schayer does not teach the picolinic acid of the claimed invention. Because Schayer does not teach each and every element of claim 36, which depends from claim 21, Schayer cannot anticipate claim 36.

Further, the Office maintained its rejections of the claims under 35 U.S.C. § 102(f). According to § 102(f), "A person is entitled to a patent unless...he did not himself invent the subject matter sought to be patented." Therefore, the Office appeared to allege that Jose A. Fernandez-Pol, the named inventor in the present application, did not invent the subject matter of the present application, and thus, would not be entitled to a patent. The Office alleged that the

“subject matter of the instant application has been previously disclosed in U.S. Patent Nos. 5,767,135, 6,127,393, 6,403,618, 6,407,125, 6,410,570, and 6,441,009, which are invented by Jose A. Fernandez-Pol.” (Emphasis Added).

For a variety of reasons, an inventor’s lack of cooperation in the filing and prosecution of an application is not an uncommon situation. Not surprisingly, the patent rules provides for the filing and prosecution of an application without the participation or cooperation of a hostile inventor. Pursuant to 37 C.F.R. § 1.47(b), Applicant filed a petition to act on behalf of Dr. Pol, the hostile inventor. Applicant submits herewith a copy of the petition, the signed declaration on behalf of the hostile inventor, and the assignment. It is well-established in the patent rules that an assignee, in this case, Novactyl, may act on behalf of the named inventor in the prosecution of the application. Novactyl does not contend that it is the inventor of the claimed subject matter of the instant application. The instant application named Jose A. Fernandez-Pol as the inventor. The Office correctly acknowledged that Jose A. Fernandez-Pol is the inventor of the ‘135, ‘393, ‘618, ‘125, ‘570 and ‘009 patents. Therefore, inventorship in the present application and the cited patents are all the same. Moreover, all of the patents and the instant application are commonly owned by Novactyl.

Furthermore, Applicant’s attorney contacted the Office regarding this rejection. The Office indicated that it had received letters from Dr. Pol, the contents of which influenced the Office’s decision to make this rejection. Upon review of the letters, Applicant’s attorney noted that Dr. Pol never denied that he was the inventor or stated that he was not the inventor of the claimed subject matter of the instant application. In fact, the letters do not address the instant application. The letters also do not negate inventorship in the specific patents addressed in the letters. Dr. Pol even signed at least the original declarations in the applications that led to

those patents. The Office correctly acknowledges that Dr. Pol is the inventor of the patents described above. Notably, to the best of Novactyl's knowledge, Dr. Pol has not presented any evidence to the Office to support the allegations in his letters.

Applicant respectfully requests favorable reconsideration and withdrawal of the rejection under 35 U.S.C. §102(f) for at least the following reasons: 1) Dr. Pol never negated inventorship of the claimed subject matter of the instant application in his letters; 2) his allegations are not relevant (please also see Applicant's previous response filed on October 24, 2003) to the present rejection or the present application; and 3) he did not provide the Office with any evidence to support his allegations.

DOUBLE PATENTING

The Office rejected claims 21-24 and 36-39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 8, 13-15 and 22 of U.S. Patent No. 6,407,125 or claim 1 and 4-7 of U.S. Patent No. 6,127,393, or claims 1-25 of U.S. Patent No. 6,410,570. Applicant would like to defer addressing this rejection until it has received an allowance of at least one claim.

OBJECTIONS

The Office objected to claims 22-24, 37 and 38 because they depend from a rejected claim, claim 21. For the reasons discussed above, Applicant respectfully submits that claim 21, which has been amended, is in proper condition for allowance. Accordingly, its dependent claims should also be allowed.

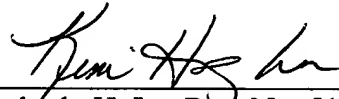
Conclusion

All of the stated grounds of rejection and objection have been properly traversed, accommodated, or rendered moot. Applicant, therefore, respectfully requests that the Office

reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Office believes, for any reason, that personal communication will expedite prosecution of this application, it is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kim H. Lu', is written over a horizontal line.

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